

passing the aged composition from said reservoir through a shear pump to a storage tank.

Remarks

Claims 10 and 15 were amended to correct a misspelling. Claim 23 is a new claim that is claiming a method of making the composition. No new matter was introduced.

The 35 USC §103 Rejection

Claims 1-22 are rejected under 35 USC §103(a) as being unpatentable over Dubin (US 5,284,492).

Argument

The threshold issue under Section 103 is whether the Examiner has established a *prima facie* case for obviousness.

“The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988) (citations omitted).

In establishing a *prima facie* case of obviousness, the PTO “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention”. *Id.* at 1600. Rather, “[t]he test is whether the claimed invention as a whole, in light of all of the teachings of the references in their entireties, would have

been obvious to one of ordinary skill in the art at the time the invention was made”.

Connell v. Sears, Roebuck & Co., 220 USPQ 193, 199 (CAFC 1983).

Applicant respectfully suggests the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, one of the criteria that must be met is that “the prior art reference (or references when combined) **must teach or suggest all claim limitations**. The teaching or suggestion to make the claimed combination must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991).” MPEP Chapter 2142. (Emphasis this author’s.)

Claim 1 of the instant application has the limitation of a “reciprocating engine”. Claims 2 through 22 of the instant application are all dependant on Claim 1. Dubin does not teach nor does it suggest the limitation of a “reciprocating engine.” Dubin is concerned exclusively with a fuel for gas turbines, which are not reciprocating engines. As defined in the Meriam-Webster Collegiate online dictionary (www.m-w.com), a reciprocating engine is “an engine in which the to-and-fro motion of one or more pistons is transformed into the rotary motion of a crankshaft”. As is well known, a gas turbine does not use pistons, but rather transfers energy from the combusted fuel directly through the rotation of the turbine blades, which in turn rotates the turbine shaft. Since there is no teaching nor suggestion in Dubin of the limitation of a “reciprocating engine”, applicant respectfully submits that the examiner has failed to establish a *prima facie* case of obviousness as required by the MPEP.

The 35 USC §112 Rejections

Claims 10, 12, 15 and 16 stand Rejected under 35 U.S.C. §112.

Argument

Claims 12 and 16 as originally filed contained the term “ICI HYPERMER E 464”. Applicant amended claims 12 and 16 to overcome an indefiniteness rejection. The amended claims 10 and 15 replaced the term “ICI HYPERMER E 464” with the equivalent “a non-ionic polymeric dispersant.” In the instant office action, the Examiner states that “[T]here is no support in the specification as filed for the now claimed limitation of a non-ionic polymeric dispersant (claims 12 and 16).” (Office Action at page 4, 2nd full paragraph.) “Where the identification of a trademark is introduced by amendment, it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter.” MPEP §608.01(v). The concurrently filed Declaration of Dennis L. Endicott states that “those of ordinary skill in the art of fuel emulsions would have known at the time of filing, July 1, 1998, that ICI HYPERMER E 464 is equivalent to ‘a non-ionic polymeric dispersant.’ ” (Declaration of Dennis L. Endicott at paragraph 5.) Thus, it is shown that characteristics of ICI HYPERMER E 464 at the time of filing were known to be equivalent to an “a non-ionic polymeric dispersant.”. Therefore, based upon the above, the Examiner’s §112 rejection has been traversed.

Claims 10 and 15 as originally filed contained the term “PLURONIC 17R2”. Applicant amended claims 12 and 16 to overcome an indefiniteness rejection. The amended claims 12 and 16 replaced the term “PLURONIC 17R2” with the equivalent “an EO/PO block copolymer having approximately between 20 weight percent ethylene oxide

(EO) and an approximate molecular weigh of the propylene oxide (PO) block of about 1700." In the instant office action, the Examiner states that "[T]here is no support in the specification as filed for the now claimed 'EO/PO block copolymer having approximately between 20 weight percent ethylene oxide (EO) and an approximate molecular weight of the propylene [sic] oxide (PO) block of about 1770' (claims 10 and 15)." (Office Action at page 4, 3rd full paragraph.) The concurrently filed Declaration of Dennis L. Endicott states that "those of ordinary skill in the art of fuel emulsions would have known at the time of filing, July 1, 1998, that PLURONIC 17R2 is equivalent to 'an EO/PO block copolymer having approximately between 20 weight percent ethylene oxide (EO) and an approximate molecular weigh of the propylene oxide (PO) block of about 1700.' " (Declaration of Dennis L. Endicott at paragraph 4.) Thus, it is shown that characteristics of PLURONIC 17R2 at the time of filing were known to be equivalent to an "EO/PO block copolymer having approximately between 20 weight percent ethylene oxide (EO) and an approximate molecular weigh of the propylene oxide (PO) block of about 1700". Therefore, as above, the Examiner's §112 rejection has been traversed.

The Double Patenting Rejection

The examiner rejected claims 1 through 22 under the judicially created doctrine of double patenting as being unpatentable over claims 1-19 of patent application serial number 09/109,028.

Remarks

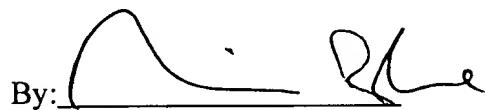
Applicant is filing, concurrently with this response, a terminal disclaimer.

For the above reasons, Applicant respectfully requests that claims 1-23 be allowed.

No additional fee is due.

On the basis of the above remarks, early consideration of this application and early allowance are respectfully requested.

Respectfully,

By: 

Michael A. Blake
Attorney for Applicant
Reg. No. 42,333

Date: November 15, 2001

Sierra Patent Group
P.O. Box 6149
295 Highway 50, Suite 20
Stateline, Nevada 89449

Telephone: (775) 586-9500
Facsimile: (775) 586-9550

RECEIVED
OCT 02 2002
OFFICE OF PETITIONS